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EXAMINER

SIMITOSKI, MICHAEL J

ART UNIT

PAPER NUMBER

2134

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DELIVERY MODE

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|------------------------------|---|--------------------------------------|--|
| Office Action Summary | Application No. 10/717,650 | Applicant(s) ZAKARIA, ZIAD | |
| | Examiner MICHAEL J. SIMITOSKI | Art Unit 2134 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 December 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3,6,7 and 10 is/are rejected.
- 7) ☒ Claim(s) 2,4,5,8 and 9 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 November 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The response of 12/7/2007 was received and considered.
2. Claims 1-10 are pending.

Response to Arguments

3. Applicant's arguments filed 12/7/2007 have been fully considered but they are not persuasive.
4. Applicant's response (p. 5) argues that the portable equipment in the invention carries information indicative of its location, but Hughes does not teach this. However, Hughes discloses that the information sent to the reader will only be received if the device is in range. Therefore, it is submitted that the data sent is itself indicative of the location of the device. The challenge value is the data indicative of the location of the portable device. It is noted that in the specification and indeed the invention disclosed, the data stored in the antitheft device and system is only "indicative" of the equipment's location because the system can use this data to infer a location. In the same light, Hughes teaches data indicative of the device's location.

Claim Objections

5. Claims 1-10 are objected to because of the following informalities:
 - a. Regarding claim 1, the limitation "a the location" (line 3) should be replaced with "a location" or "the location".
 - b. Regarding claim 6, the limitation "from external" should be replaced with "from the external" (last line).

Appropriate correction is required.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 1 & 6 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent 6,842,106 to Hughes et al. (**Hughes**).

Regarding claim 1, Hughes discloses an antitheft device (authenticator/reader, col. 6, lines 16-17 & col. 7, lines 59-65) for portable electronic equipment (RFID tag, Fig. 2, #44) comprising a microprocessor (processor, Fig. 2, #54) and a communication module (antenna, Fig. 2, #34) for connection to an external communication network (RF (radio frequency) network, Fig. 2, #30), said microprocessor including data (challenge from random number generator, col. 6, lines 19-29) indicative of a location of said electronic equipment (challenge is used to confirm a device is in range, Fig. 3, col. 1, lines 30-34 & col. 8, lines 4-8), an output to provide said information to said communication module (antenna receives challenge, col. 6, lines 28-29) and a comparator (processor) to compare a response (challenge response) from said communication module (antenna receives challenge response and compares it to pre-calculated response, col. 6, lines 33-44) to a predetermined response (value computed

by Authenticator/reader, col. 6, lines 42-44) and thereby determine whether said equipment is in a desired location (col. 7, line 59 – col. 8, line 6).

Regarding claim 6, Hughes discloses providing data indicative of a desired location (in range) of said electronic equipment (RFID tag, Fig. 2, #44) to an external communication network (RF network, Fig. 2, #30; a challenge, which is used to confirm that the device is in range (location), is sent to the RF network, col. 1, lines 30-34, col. 6, lines 19-29 & col. 8, lines 4-8), comparing a response from said external communication network to a predetermined response (antenna receives challenge response and compares it to pre-calculated response, col. 6, lines 33-44, which is a value computed by Authenticator/reader, col. 6, lines 42-44) and acknowledging removal of said electronic equipment from said desired location if said response from the external communication network differs from said predetermined response (confirm the RFID tag is not in range, col. 7, line 59 – col. 8, line 6).

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 3, 7 & 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Hughes**, as applied to claims 1 & 6 above, in further view of U.S. Patent Application Publication 2003/0204739 to Ng et al. (**Ng**).

Regarding claims 3 & 7, Hughes lacks upon receipt of a response other than said predetermined response, utilizing additional data with said external communication network to indicate a theft. However, Ng teaches that RF mechanisms (§116) can be used to protect high valued items against theft (§116), such that a component database is maintained with identification of all components (§134) where the components are polled periodically (§137) to determine if they are in a certain location (§138) and in response, each component responds with an identifier (§140) and a tampering status (§§140-41), where, upon a tampering status being other than a predetermined response (predetermined response is a value that indicates no tampering, §141), a microprocessor (reader, §141) uses additional data (relevant information regarding details of the type of tampering, §141) with an external communication network (page to a representative via radio network, §142) to indicate a theft of said equipment (§142). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Hughes such that each RF tag responds also with a tampering indication and upon receipt of a signal indicating that a tampering has occurred (response other than a predetermined response), using additional data (details of the type of tampering) in the microprocessor (reader) with said external network (radio network) to indicate a theft of the equipment (page to representative). One of ordinary skill in the art would have been motivated to perform such a modification to protect the configuration of a digital cinema system, as taught by Ng (§18).

Regarding claim 10, Hughes discloses a continuous polling signal, but lacks explicitly performing the steps on a periodic basis. However, Ng teaches initiating a polling mechanism that, at various time intervals, polls components to determine theft (¶¶39-40). One of ordinary skill understands that the polling at regular intervals allows a theft to be determined at each time (as opposed to, for example, polling only once). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Hughes to explicitly determine if the RFID tag is in range on a periodic basis. One of ordinary skill in the art would have been motivated to perform such a modification to determine if the equipment is stolen over time, as taught by Ng.

Allowable Subject Matter

10. Claims objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims and amended to overcome any rejections under 35 U.S.C. § 112 and/or claim objections indicated in this Office Action.

c. Regarding claim 2, the prior art of record fails to teach or disclose, either alone or in combination, wherein said data is a telephone number of a location and said predetermined response is a busy signal from an external communication network, in combination with the other elements of the claim.

d. Regarding claim 4, the prior art of record fails to teach or disclose, either alone or in combination, wherein said data is a telephone number of a location, said predetermined response is a busy signal from an external communication

network, and said additional data is a telephone number of a security authority, in combination with the other elements of the claim.

e. Regarding claim 5, the prior art of record fails to teach or disclose, either alone or in combination, user-accessible software allowing said data indicative of the location of said electronic equipment to be modified by a privileged user, in combination with the other elements of the claim.

f. Regarding claim 8, the prior art of record fails to teach or disclose, either alone or in combination, wherein said additional data also includes data for determining the present location of said electronic equipment, in combination with the other elements of the claims.

g. Regarding claim 9, the prior art of record fails to teach or disclose, either alone or in combination, modifying desired location of said electronic equipment whenever prompted by a privileged user, in combination with the other elements of the claims.

Conclusion

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened

statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MICHAEL J. SIMITOSKI whose telephone number is (571)272-3841. The examiner can normally be reached on Monday - Thursday, 6:45 a.m. - 4:15 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kambiz Zand can be reached on (571) 272-3811. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

March 3, 2008
/M. J. S./
Examiner, Art Unit 2134

/Kambiz Zand/
Supervisory Patent Examiner, Art Unit 2134